

REMARKS

Claims 1-29 have been restricted under 35 U.S.C. § 121 and 372 among the following groups:

Group I, claims 1-9 and 25-29 drawn to nucleic acid constructs encoding two starch synthase genes or fragments thereof, methods of their use to produce transformed plants, the resultant transformed plants, and methods of their use to obtain modified starch;

Group II, claim 10, drawn to a method of using a transformed plant to produce a food product; and

Group III, claims 11-24, drawn to isolated starch and method of its use in paper, textile, adhesive or food processing.

Applicants provisionally elects Group III with traverse.

An Examiner's authority to require restriction is defined and limited by statute:

If two or more independent and distinct inventions are claimed in one application, the Commissioner may require the application to be restricted to one of the inventions. 35 U.S.C. § 121, first sentence (emphasis added).

The Implementing regulations of the Patent and Trademark Office include the mandate that restriction is appropriate only in cases presenting inventions which are both independent and distinct, 37 C.F.R. §§ 1.141-142. Without independence and distinctness, a restriction requirement is unauthorized. Applicants' claims are very clearly interrelated and interdependent, not "Independent and distinct."

In the present application, the claims which the Examiner has grouped separately are not "independent and distinct" so as to justify the restriction requirement. The claims of Group I include the plants from which the starch of Group III may be extracted. Group II is directed to the use of the plants of Group I. Thus, it is clear that all the groups are interrelated and interdependent, and not "independent and distinct".

The interdependence of these groups is confirmed, indeed, it is mandated, by virtue of the fact that the description requirements of U.S.C. § 112 compel disclosure of all aspects of the invention in the one application which Applicants have filed. An application claiming compositions (e.g. the starch) is required to disclose, *inter alia*, how to make that composition. In other words, the description of a process making those compositions is a mandatory part of the application to the compositions. Indeed, if any of these aspects of a complete disclosure were omitted, perhaps by an Applicant relying on what the Patent and Trademark Office considers "Independent and distinct," the

application may be considered defective under § 112, first paragraph. Consequently, it is clear that aspects of a given invention, such as compositions and the materials for making the compositions are necessarily interdependent, not independent, from each other.

In view of the foregoing, Applicant respectfully requests that the restriction be withdrawn and the entire application examined on the merits.

Respectfully submitted,



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